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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,570	08/16/2001	James Russell Hornsby	6881.01	4261
25763	7590	03/09/2004	EXAMINER	
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/931,570	<b>Applicant(s)</b> HORNSBY ET AL.	
	<b>Examiner</b> Dmitry Suhol	<b>Art Unit</b> 3712	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-10, 12, 13, 16-21, 24-31, 33-38 and 40-49 is/are pending in the application. \_\_\_\_\_
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10, 12-13, 16-21, 24-31, 33-38, 40-49 is/are rejected.
- 7) ☒ Claim(s) 20 and 42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

The terminal disclaimers filed on 11/20/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Copending applications 09/966680 and 10/071545 have been reviewed and are accepted. The terminal disclaimers have been recorded.

### ***Claim Objections***

Claims 20 and 42 are objected to because of the following informalities: It is unclear if the applicants have canceled claims 20 and 42 since the claims submitted 11/20/2003 do not show claims 20 and 42 being canceled, but the first page of the amendment discloses that applicants canceled claims 20 and 42. Clarification regarding the status of claims 20 and 42 is required. For purposes of examination it is assumed that the claims have not been canceled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

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to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 20 and 42, the phrase "data-reader writer writes data to the data storage device" was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There does not appear to be any support for the data reader-writer writing to a storage device in the specification. Although the examiner understands that these devices are well known in the art, the examiner is not clear on the "structure" which enables the "data-reader" to function in the disclosed and claimed invention. Please refer to the examiners response to arguments for more explanation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-13, 16-21, 24-31, 43, 46-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 12, 13, 21, 43, the metes and bounds of the claims could not be determined due to the phrase "and/or".

Regarding claim 49, appears to be an exact duplicate of parent claim 47. It seems that the claims should be depended from claim 48 rather than 47. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-11, 13, 17-20, 33, 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al in view of Mathieu et al. Lebensfeld discloses an interactive amusement device capable of a variety of scenarios and using a multiple of different accessories (col. 4, lines 56-62), containing most of the elements of the claims including, a body as required by claims 1, 12-13, 21, 33, 43 (fig. 4, element 10), a transport element/limbs movably connected to a body as required by claims 1, 5, 10, 12-13, 19, 21, 31, 33, 41 (fig. 1, legs), a microprocessor as required by claims 1, 12-13, 23, 33, 43 (figure 6, element 60), a data reader-writer operably coupled to a microprocessor, as required by claims 1, 13, 23, 33, 43 is inherent since the device is made to upload and download upgrade data from/to a data storage device to enhance/add a function(s) of the device as required by claims 1, 11, 13, 20, 23, 26, 32-33, 36, 42-43 (fig. 5, element 49 and col. 9, lines 35-43), a data storage device being separate from the amusement device, as required by claims 1, 13, 21, 33, 43 (figure 5, col. 9, lines 35-43) where the use of a computer is described in which case a disk/CD/ or computer internal memory would be used as the storage device and is certainly separate from the amusement device. Furthermore, Lebensfeld not only teaches that the function of his device can be enhanced through programmable backpacks (22) in

col. 9, lines 35-43, but goes further to teach that his backpacks can have a variety of functions including increased speed, as required by claim 1, 12, 13, 21, 33, 35 and 43 in col. 6, lines 26-46 where shot speed is clearly increased from a single shot to semi-automatic and even further with a fully automatic shot operation. At least two arms moveably connected to a body as required by claims 21, 33, 43 is shown in fig. 1 as elements 47 and further described in col. 7, lines 31-36.

Although Lebensfeld et al discloses most of the elements of the claims the reference fails to teach a motor associated with a body and coupled to a transport element as required by claims 1, 5, 13, 17, 23, 33, 43, a wireless receiver operably coupled to a microprocessor as required by claims 6, 13, 33, 43, a unit wireless transmitter associated with a body and coupled with a microprocessor as required by claims 8, 13, 33, 43, a remote wireless transmitter operably coupled with a wireless receiver as required by claims 7, 13, 33, 43, at least two wheels as required by claims 9, 18, 30, 40, 43. However, Mathieu discloses an interactive amusement device like that of Lebensfeld, which teaches a motor associated with a body and coupled to two transport elements (fig. 6, elements 42), a wireless receiver associated with a body (fig. 8, element 64), a unit wireless transmitter associated with a body and coupled with a microprocessor (figure 1, element 20), a remote wireless transmitter operably coupled with a wireless receiver (figure 1, element 46) and at least two wheels (fig. 1, elements 38). Therefore it would have been obvious in view of Mathieu, to manufacture the device of Lebensfeld with the above mentioned features for the purpose of providing a remote controlled moving device that can simulate a "battle" scenario.

Claims 4, 12, 16, 34-38, 44-47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al and Mathieu et al, in view of Li et al. Lebensfeld, as modified by Mathieu, discloses most of the elements of the claims, as stated above, and further including a means for powering the toy as required by claim 12 (col. 6, line 55), as well as the device being mobile (col. 9, lines 49-52). The reference fails to teach a data storage device being a card as required by claims 4, 12, 16, 38, enhancement data increasing the mobility of the device as required by claim 34, an additional function comprising a punching motion as required by claim 37, a card game utilizing a number of data storage cards as required by claims 44, 46, 48 and amusement device receiving information from data storage cards that complement a card game as required by claim 45, 47, 49. However, Li discloses an interactive amusement device, which teaches the use of a data card and data card reader to upgrade certain functions of a device (fig. 20, col. 7, lines 50-64) such as mobility, speed and sound. Li further teaches that the cards of his device are usable to play a card game (i.e. the cards of Li are collectable, such as baseball cards which are used to play card games, see col. 5, lines 19-20) and that his toy device receives information from the data storage cards that complement/respond to a card game (col. 4, lines 38-53). Therefore it would have been obvious, in view of Li, to use a card as a data device for the purpose of manufacturing the device of Lebensfeld, as modified by Mathieu, with easily upgradeable functions such as sound and movement and providing a data card that can be a collectible, especially since Lebensfeld discloses a variety of

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scenerios and functions envisioned with his toy (col. 10, lines 44+). It would have been further obvious to make an additional function be a punching motion since Lebensfeld discloses a variety of scenerios and functions envisioned with his toy (col. 10, lines 44+) and toy figures with punching features are well known in the art.

Claims 21, 23, 26, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al and Mathieu et al, as stated above, in view of Wilde, Suda or Carver et al. Lebensfeld, as modified by Mathieu, disclose most of the elements of the claims, as stated above, but for a motor operable coupled to at least two arms. However, Wilde, Suda and Carver all disclose a remote control interactive toy which teach a motor coupled to at least two arms (figure 1). Therefore it would have been obvious to couple the arms of Lebensfeld, as modified by Mathieu, to a motor to provide a more realistic toy and interest to the consumer.

Claims 24-25, 27-29, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al, Mathieu et al, Wilde, Suda or Carver et al, as stated above, in view of Li et al. Lebensfeld, as modified by Mathieu, Wilde, Suda or Carver, discloses most of the elements of the claims, as stated above, but for a data storage device being a card as required by claims 28-29, enhancement data increasing the mobility of the device as required by claim 24, enhancement data increasing the speed of the device as required by claim 25, an additional function comprising a punching motion as required by claim 27. However, Li discloses an interactive amusement



device, which teaches the use of a data card and data card reader to upgrade certain functions of a device (fig. 20, col. 7, lines 50-64) such as mobility and speed. Therefore it would have been obvious, in view of Li, to use a card as a data device for the purpose of manufacturing the device of Lebensfeld, as modified by Mathieu, with easily upgradeable functions such as sound and movement, especially since Lebensfeld discloses a variety of scenerios and functions envisioned with his toy (col. 10, lines 44+). It would have been further obvious to make an additional function be a punching motion since Lebensfeld discloses a variety of scenerios and functions envisioned with his toy (col. 10, lines 44+) and toy figures with punching features are well known in the art.

### ***Response to Arguments***

Applicant's arguments filed 20 November 2003 have been fully considered but they are not persuasive. Applicants arguments regarding rejections under 35 USC 112, First Paragraph are unclear. Specifically it is unclear if the applicants have canceled claims 20 and 42 since the claims submitted 11/20/2003 do not show claims 20 and 42 being canceled, but the first page of the amendment discloses that applicants canceled claims 20 and 42. Clarification regarding the status of claims 20 and 42 is required.

Applicants further argue that there is no motivation to combine the Lebensfeld and Mathieu references. The examiner disagrees and points out that both of the references clearly discloses interactive toys that shoot at each other using IR light. Lebensfeld teaches toys that are upgradeable and utilize mechanical and electrical

components including a motor that moves the figure or part of in response to a hit. Mathieu, like Lebensfeld, discloses interactive toys that shoot at each other which also utilize mechanical and electrical components including a motor and remote controls. Thus both reference are clearly concerned with providing a "battle scenario" while Mathieu clearly adds the objective of a remotely controlled toy/system (col. 2, lines 1-3), therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have provided the device of Lebensfeld with the remote control features of Mathieu for the purpose of providing a remote controlled moving device that can simulate a "battle" scenario.

In response to applicants arguments that Lebensfeld does not contain any additional elements than the Mathieu patent the examiner points out that the Lebensfeld reference is the base reference and the Mathieu is used to add the remote controls elements and mobility to the Lebensfeld reference.

Regarding applicants arguments with respect to a separate data card and enhanced functions as recited in the claims, the examiner directs the applicants attention to the above rejection.

Regarding applicants argument that the combination of Lebensfeld, Mathieu and Li fails to teach or suggest a data storage device which enhances a function being at least one of increased mobility, increased speed and expanded defense and diminished defense. In response the examiner points out that Lebensfeld discloses that his device can be mobile (e.g. can move a variety of body parts via a motor, see col. 9, lines 50-52) whose variety of functions can be upgraded (col. 9, lines 35-43). Li teaches a mobile

toy device whose functions (e.g. audio and movement/speed) are upgraded via a card. Therefore in lieu of the combination of the two references, it would have been obvious to enhance the mobility, speed function of Lebensfeld for the purpose of interest/amusement to the consumer.

Applicants further argue that Li fails to teach that the movements/speed of the device is enhanced through his upgrade card. The examiner disagrees, since Li's device does not move prior to the insertion of his upgrade card, thus the examiner interprets that the movement function and speed of the toy device of Li is upgraded via the card. In other words since after insertion of the card into the toy of Li the toy begins to move the movement function is enhanced and the speed function is as well (e.g. the speed goes from 0 to some measurable value).

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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